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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,411	06/30/2003	Scott Manzo	017516-009700US	2194

7590 06/30/2006

PATENT DEPT  
INTUITIVE SURGCAL. INC  
950 KIFER ROAD  
SUNNYVALE, CA 94086

EXAMINER
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VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/611,411

Applicant(s)

MANZO ET AL.

Examiner

Peter J. Vrettakos

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 3-14-06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 49-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-19 and 49-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-26-03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

**All prior rejections are obviated.**

**RCE filed 3-14-06. Pending claims are 1-19 and 49-52.**

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-19 and 49-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims both include language toward an insulative sleeve that inhibits conduction of electrical current flowing from the electrode to the electrosurgical instrument. The word "surface" (referring to the longitudinal surface of the instrument) inserted just prior to the claimed phrase "conduction of electrical current" would rectify this indefiniteness. Currently the language is counterintuitive as it reads that the sleeve prevents the flow of current between the electrosurgical device including current source and the electrode.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 includes the non-sensical phrase, "and one of the at least one internal sealing ring". Amendment is required.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borgmeier et al. (6,090,107) in view of Weaver et al. (5,496,315).

*(All parentheticals refer to Borgmeier et al. unless stated otherwise.)*

The prior art discloses an end effector device (see figure 4) and method of manufacturing comprising:

an RF (col. 4:1-4) electrode (56) probe;  
a removable and mechanical coupling mechanism (threading 44, 66; inherently disposable);  
an insulative sleeve (61) around an insulation layer (60);  
a sealing ring (Weaver et al.; o-ring 19); and  
an insulation layer (60) around the electrode (56) and the o-ring (obvious; Weaver et al.; o-ring 19).

Burgmeier et al. discloses the desire for a tight fluid seal (with element 61) to prevent accumulation of contaminants in col. 2:48-51 and col. 7:49-52. Burgmeier et al. is silent, however, regarding a sealing ring (o-ring).

Weaver et al. in an analogous electrosurgical device discloses an insulative sleeve with an o-ring to prevent accumulation of contaminants (col. 1:35-43).

Regarding claims 17-18, plastic materials in the sleeve (61) and layer (60) are found in Burgmeier et al. col 5:4-11.

Obvious design choices in claims 7-11, 14-15, 51, 52  
(spring tabs, latching members, gripping members, electrical tabs, two sealing rings)

Notwithstanding most of the above elements are different species with different figures, the elements are obvious design modifications. The Applicant in the Specification shows no criticality or unexpected result associated with the elements.

With regards to a proximal sealing ring (claims 51, 52), it would be obvious to place at the proximal end of element 61 in figure 5 of Burgmeier et al. an o-ring (Weaver et al. 19). This is especially true because Burgmeier discloses the benefits of the sealing effect (col. 2:48-51 and col. 7:49-52) of the entire element 61 and not just its distal tip. This sealing effect would be potentiated through the proximal placement in element 61 the o-ring (19) disclosed in Weaver et al.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Burgmeier et al. in view of Weaver et al. by including in the Burgmeier et al. electrosurgical device an o-ring as seen in the Weaver et al. electrosurgical device the motivation being to potentiate the advantageous sealing effect of Burgmeier et al. element 61.

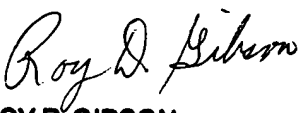
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pete Vrettakos  
June 26, 2006



  
**ROY D. GIBSON**  
PRIMARY EXAMINER